

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Weaver Jr. et al.)	Examiner: H. Jey Tsai
)	
Serial No.: 10/582,377)	Art Unit: 2895
)	
Filed: March 29, 2007)	Confirmation: 3872
)	
For: SURFACE MOUNT LIGHT EMITTING)	
CHIP PACKAGE)	
)	
Mail Date of Last Office Action:)	
December 28, 2010)	
)	
Attorney Docket No.:)	Cleveland, OH 44114
GLOZ 2 00196 / 137295)	January 10, 2011

**PETITION FOR WITHDRAWAL OF PREMATURE FINALITY
OF THE OFFICE ACTION MAILED DECEMBER 28, 2010**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Petitioners hereby petition for withdrawal of the finality of the Office Action mailed December 28, 2010, on the basis that it is premature.

Relevant facts

A first Office Action on the merits was mailed March 31, 2010. In this first Office Action claims 21, 22, 24, and 25 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Ishinaga et al., U.S. Pat. No. 6,093,940 (hereinafter "Ishinaga"). Claim 23 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ishinaga in view of Perduijn et al., U.S. Pat. No. 6,392,778.

Petitioners filed Amendment A on or about June 29, 2010 responsive to the first Office Action. Amendment A placed claim 21 into independent form including *all* limitations of the *original* base claims 1, 17, 18, and 19. Claims 22-25 were not amended. Petitioners emphasized in the "Remarks" section of Amendment A that:

Claim 21 is placed into independent form including all limitations of intervening base claims 1, 17, 18, and 19. *It is respectfully submitted that the scope of claims 21-25 is unaltered by this amendment.*

Amendment A at page 9 (italics in original).

A Written Restriction was mailed September 22, 2010.

Petitioners filed Response B on or about October 22, 2010. Response B did not amend *any* claim of the application. A listing of the claims was provided in Response B, with the heading "Claims: (not amended herein)". In the "Remarks" section of Response B, Petitioners emphasized:

For the Examiner's convenience, a listing of the currently pending claims is included herewith. There are no claim amendments presented herein.

Response B at page 9.

A second Office Action on the merits was mailed December 28, 2010. The second Office Action now rejects claims 21-25 under 35 U.S.C. § 103(a) as allegedly unpatentable over Peterson et al., U.S. Pat. No. 6,674,159 (hereinafter "Peterson") in view of Kropp, U.S. Pub. No. 2004/0136658 (hereinafter "Kropp"). Office Action page 3. Both Peterson and Kropp are listed in the "Notice of References Cited" included with the second Office Action, and the Office Action refers to "the newly cited references". Office Action page 10.

The second Office Action has been made FINAL. The Office Action states:

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Office Action mailed December 28, 2010.

No Information Disclosure Statement has been filed by Petitioners between the interval of the first Office Action mailed March 31, 2010 and the second Office Action mailed December 28, 2010.

MPEP Standard for Finality on Second Office Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP § 706.07(a).

Petition

Petitioners petition for withdrawal of the finality of the Office Action mailed December 28, 2010 as being premature. The basis for this petition is as follows.

Claims 21-25 have *never* been substantively amended. The only amendment of these claims prior to the December 28th issuance date of the Office Action was in Amendment A, in which claim 21 was placed into independent form.

In the first Office Action claims 21, 22, 24, and 25 were rejected under § 102(b) as allegedly anticipated by Ishinaga, while claim 23 was rejected under § 103(a) as allegedly unpatentable over a proposed combination including Ishinaga and a secondary reference.

In the second Office Action, claims 21-25 are now rejected under § 103(a) as allegedly unpatentable over a proposed combination of Peterson and Kropp.

These *new rejections* of claims 21-25 are *not* necessitated by Applicant's amendment, because claims 21-25 have not been substantively amended between the first Office Action mailed March 31, 2010 and the second Office Action mailed December 28, 2010.

Accordingly, Petitioners respectfully submit that the finality of the second Office Action mailed December 28, 2010 is premature. MPEP § 706.07(a).

Petitioners therefore earnestly request that the petition to withdraw finality of the Office Action mailed December 28, 2010 be granted.

No fee is believed due for the filing of this Petition; however, if this is not the case, the Commissioner is hereby authorized to charge any and all fees due for this Petition to Deposit Account No. 06-0308.

Respectfully submitted,

FAY SHARPE LLP

A handwritten signature in dark ink, appearing to read "Robert M. Sieg", is written over a horizontal line.

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